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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,317	11/21/2003	Sumita Rao	UTL 00388	3079
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EXAMINER				
WIENER, ERIC A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,317

Applicant(s)

RAO, SUMITA

Examiner

Eric Wiener

Art Unit

2179

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is responsive to the following communications: Amendment filed on 8/4/2009.

This action is made final.

2. Claim 30 is pending. Claims 1 – 29 have been cancelled. Claim 30 is the independent claim. Claim 30 has been rejected by the Examiner.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Noesgaard et al. (US 7,113,809 B2) in view of Haller et al. (US 6,909,878 B2) and further in view of Giacalone, Jr. (US 7,228,341 B2).

As per independent claim 30, Noesgaard discloses *a method for arranging and playing a media presentation* (Abstract), *comprising:*

- *receiving a selection of a plurality of media objects to be included in a media presentation* (column 2, lines 23 – 52 column 6, lines 42 – 50);

- *receiving configuration instructions for ordering the plurality of media objects in the media presentation* (column 6, lines 42 – 50);
- *providing a wireless communication device with an association list that identifies a trigger event to be associated with a media package* (column 5, lines 16 – 23).

It has been interpreted that the providing of predetermined information corresponding to media objects in different manners sufficiently corresponds to providing an ordered sequence of media objects associated with an association list that identifies a trigger event.

Noesgaard does not explicitly disclose generating a media package comprising the selected media objects in said order and transmitting the media package to a wireless communication device.

Nevertheless, in an analogous art, Haller discloses:

- *generating a media package comprising the selected media objects in said order* (column 8, lines 3 - 8) *and*
- *transmitting the media package to a wireless communication device* (column 3, lines 28 – 30, column 7, lines 65 – column 8, line 8; column 8, lines 40 – 54; and column 13, lines 16 – 20).

Both Noesgaard and Haller pertain to the analogous art of providing arrangements of multimedia files such as screen savers to mobile phones (Noesgaard, Abstract and Haller, column 2, lines 29 – 53). Therefore, one would look to the other for possible improvements upon their inventions. Furthermore, Haller discloses that, regarding such multimedia arrangements like that of Noesgaard, a user may be interested in having all or some of the multimedia arranged

through such means as related themes that may be changed without user intervention (Haller, column 2, lines 17 – 25). Therefore, because it is desirable that such multimedia arrangements be communicated without a request from a user, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Haller with the invention of Noesgaard.

Even though Noesgard discloses identifying a trigger event to be associated with the media package (Noesgard; column 5, lines 16 – 23) and Haller discloses transmitting a media package to a wireless communication device (Haller; column 3, lines 28 – 30, column 7, lines 65 – column 8, line 8; column 8, lines 40 – 54; and column 13, lines 16 – 20), Noesgard and Haller do not explicitly disclose that a trigger event is included in an association list and that an association list is transmitted to a wireless communication device along with a media package.

Nevertheless, in an analogous art, Giacalone, Jr. discloses:

- *receiving configuration instructions for ordering a plurality of media objects in the media presentation and generating a media package comprising selected media objects in an order* (column 10, line 57 – column 11, line 27);
- *identifying a trigger event to be associated with the media package, wherein said trigger event is included in an association list* (column 2, lines 10 – 53); *and*
- *transmitting the media package and said association list to a wireless communication device* (column 1, lines 24 – 30; column 2, lines 3 – 9 and 54 – 62; and column 13, lines 31 – 40).

Noesgaard, Haller, and Giacalone, Jr. all pertain to the analogous art of providing arrangements of multimedia files to devices such as wireless communication devices

(Noesgaard, Abstract; Haller, column 2, lines 29 – 53; and Giacalone, Jr., column 1, lines 49 – 52). Therefore, one would look to the others for possible improvements or modifications to their inventions. Furthermore, Giacalone, Jr. discloses that there is a known desire for the improvement of scheduling abilities relating to the providing of association lists pertaining to scheduling and triggering of presentations of media, because current scheduling abilities require considerably costly and time consuming overhead to distribute to devices (Giacalone, Jr., column 1, lines 49 – 67). Therefore, it would be desirable for Noesgaard and Haller to incorporate teachings of Giacalone, Jr. to lessen such possible overhead relating to scheduling and distribution of media in their analogous systems, and thus it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Noesgaard, Haller, and Giacalone, Jr..

Response to Arguments

5. Applicant's arguments filed on 8/4/2009 have been fully considered, but are not persuasive.
6. The Applicant has argued that column 5, lines 16 – 23 of Noesgaard "does not disclose identifying a trigger event to be associated with the media package, wherein said trigger event is included in an association list, as required by claim 30.... There is simply no suggestion of anything like an association list or of a trigger event in Noesgaard. Rather, what the cited Noesgaard passage is referring to is the identification of one or more items that are to be included in the media package. This linking of content disclosed by Noesgaard is very different

from the claimed steps.”

In response to this argument, the Examiner respectfully disagrees. Please refer to the rejection of claim 30, *supra*, and to Noesgaard, column 5, lines 16 – 23, wherein the disclosed “idle state” of Noesgaard suggests a trigger event, wherein the event would be well know to one of ordinary skill in the art as an event corresponding to a determination of inactivity or idleness. In addition, in the rejection of claim 30, *supra*, it is suggested that Noesgaard discloses “providing a wireless communication device with an association list that identifies a trigger event to be associated with a media package” in column 5, lines 16 – 23. This determination was made in part because Noesgaard pertains to *providing a wireless communication device with a media package* (Abstract), because Noesgaard also discloses *providing predetermined information in one predetermined manner in one state and in another manner in another state* (column 5, lines 16 – 23), and lastly because Noesgaard discloses that the user may desire to *identify which information... is to be provided during the idle state*.

Therefore, it has been interpreted that, in order to identify which information is to be provided during the idle state so that an association may be made between the information and the idle state, the idle state itself must be identified in some fashion as the trigger event. The step of identifying a trigger event, such as an idle state, has been interpreted as not necessarily requiring user input explicitly pertaining to identifying a trigger event for the actual identification of the trigger event to occur. One of ordinary skill in the art may interpret the identification of a trigger event as corresponding to a default identification provided automatically whenever the media presentations of Noesgaard (column 2, lines 23 – 52 and column 6, lines 42 – 50) are desired to be configured.

Furthermore, the disclosure that there may be "a state other than the idle state" that could trigger the media presentation, would suggest to one of ordinary skill in the art that there is some association between a media presentation and a trigger event, whether or not the association is made by default. Therefore, given its plain meaning, an "association list" may be inferred as only requiring one association, such as the association of an idle state to a media presentation. This form of an association, or association list, is required to be provided with or in reference to the media presentation of Noesgaard, because without an accompanying form of association to a trigger event, the association itself would just be an idea and not necessarily associated in any form to a media presentation, and thus the media presentation would not function in the means intended by Noesgaard, which is a screen saver for a mobile device (column 1, lines 6 - 10). Thus, for these above reasons, Noesgaard suggests "providing a wireless communication device with an association list that identifies a trigger event to be associated with a media package."

7. The Applicant has argued that column 5, lines 16 – 23 of Noesgaard "does not disclose transmitting the media package and said association list to a wireless communication device, as required by claim 30.

In response to this argument, the Examiner agrees that column 5, lines 16 – 23 of Noesgaard does not explicitly disclose transmitting the media package and said association list to a wireless communication device. However, please refer to the rejection of claim 30, *supra*, wherein it is instead suggested that Noesgaard discloses "*providing* a wireless communication device with an association list." It is not suggested that Noesgaard explicitly discloses an act of "transmitting." However, in light of the rejection of claim 30 as a whole, Noesgaard in view of

Haller and further in view of Giacalone makes obvious *transmitting* a media package and *transmitting* an association list.

Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. The Applicant has argued that “while Giacalone does reference a ‘trigger event’, there is no disclosure of a trigger event included in an association list, as required by claim 30. Rather, all Giacalone does disclose is that ‘upon receiving a receiving a trigger event, particular media content will be played.’ There is simply no teaching of maintaining the trigger event in an association list or of an association list at all in Giacalone.”

In response to this argument, the Examiner respectfully disagrees. Please refer to the rejection of claim 30, *supra*, as well as the Response to Arguments section (6.), *supra*, which explains possible interpretation that may be given to “association list.” In addition, if more than one trigger event is possible for a media presentation (such as in Noesgaard; column 5, lines 19 – 23 and Giacalone; column 2, lines 10 – 53), then it would have been obvious to one of ordinary skill that some form of association between the trigger event and the media presentation would be necessary. Therefore, the disclosure of the possibility of more than one trigger event for a media presentation would suggest to one of ordinary skill in the art that there is some association between a media presentation and a trigger event, whether or not the association is made by default. Therefore, given its plain meaning, an “association list” may be inferred as only

requiring one association, such as the association of an idle state to a media presentation. This form of an association, or association list, is required to be provided with or in reference to the media presentations of Noesgaard and Giacalone, because without an accompanying form of association to a trigger event, the association itself would just be an idea and not necessarily associated in any form to a media presentation, and thus the media presentation would not function in the means intended by Noesgaard or Giacalone.

9. The Applicant has argued that “because Giacalone fails to disclose an association list, Giacalone also necessarily fails to disclose transmitting the media package and said association list to a wireless communication device, as required by claim 30.”

In response to this argument, the Examiner respectfully disagrees. Please refer to the rejection of claim 30, *supra*, as well as the Response to Arguments sections (6.) and (8.), *supra*, which explain possible interpretation that may be given to “association list” and the reasons that Giacalone does suggest an association list. Furthermore, Giacalone's disclosure that distribution may be made across high speed networks (column 1, lines 49 – 52) suggests a wireless network as a possible means for distribution. Therefore, Giacalone's disclosure that scheduling methods may pertain to a conditional trigger among other different possible schedule methods (column 2, lines 40 – 50) and that scheduling changes may be distributed over networks (column 2, lines 54 – 57), suggests that such forms of association as an association list (which need only consist of one necessary association) are distributed across a network, and thus it may be inferred from Giacalone's disclosure by one of ordinary skill in the art that an association list is transmitted to a wireless communication device by being distributed across a high speed network to a device.

Furthermore, please refer to Giacalone, column 13, lines 31 – 40, which discloses that “the present invention can be used to *distribute* any type of communicative content along with any type of display or restriction control instructions,” whereby an association list sufficiently corresponds to a type of display or restriction control instructions.

10. The Applicant has argued that “because the Office Action admits that Noesgaard and Hailer do not disclose that a trigger event is included in an association list and that an association list is transmitted to a wireless communication device along with the media package, and because Giacalone fails to disclose an association list and fails to disclose transmitting a media package and said association list to a wireless communication device, Applicant asserts that the combination of Noesgaard, Hailer and Giacalone do not disclose every step of claim 30 and that claim 30 is therefore presently in condition for allowance.

In response to this argument, the Examiner respectfully disagrees. Please refer to the rejection of claim 30, *supra*, as well as to above explanations pertaining to these contentions in the Response to Arguments sections (6.), (7.), (8.), and (9.).

Conclusion

11. It is noted that any citation to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. In re Heck, 699 F.2d 1331, 1332-

33,216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)).

12. *The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The cited documents represent the general state of the art.*

Cited art of particular note includes, but is not limited to:

- *Kirby et al. (US 2004/0165006 A1)*
- *Lowe (US 7,123,696 B2)*
- *Merrill et al. (US 2004/0002943 A1)*
- *Freeman et al. (US 5,861,881)*
- *Hempleman et al. (US 6,243,725 B1)*
- *Irvin (US 6,360,101 B1)*
- *Wells et al. (US 5,870,683)*
- *Makipaa et al. (US 2003/0169306 A1)*
- *Farber et al. (US 5,819,284)*
- *Knepper (US 6,763,272 B2)*
- *Loughran (US 7,231,198 B2)*
- *King et al. (US 2002/0055992 A1)*
- *Fukuda (US 6,810,115 B2)*

13. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Wiener whose telephone number is 571-270-1401. The examiner can normally be reached on Monday through Thursday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Eric Wiener/
Examiner, Art Unit 2179

/Ba Huynh/
Primary Examiner, Art Unit 2179